

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MOSHE WEINER and EREZ REINSHMIDT

Appeal 2007-2159
Application 09/892,767
Technology Center 2800

Decided: November 20, 2007

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-42. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM-IN-PART.

THE INVENTION

Appellants' invention relates generally to a multimedia messaging service ("MMS") application. More particularly, Appellants' invention is related to using a multimedia messaging service based application to record and send telephone or personal computer karaoke performances to another user (Spec. 1). The disclosed invention provides a karaoke terminal that allows a user to perform, but does not require additional special karaoke equipment. Appellants' invention also provides a karaoke terminal that is portable so that a user may perform at various locations (public or private). Appellants' invention further provides a karaoke system that enables the user to treat the performance as a message which in turn allows the user to send copies of the performance to others through the user's cellular telephone or personal computer (Spec. 3-4).

Independent claim 35 is illustrative:

35. A method for recording karaoke performances as an MMS message, comprising:

storing a plurality of songs in karaoke format; and

recording a selected one of said songs as an MMS message.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

| | | |
|----------|--------------|---------------|
| Landante | US 5,555,017 | Sep. 10, 1996 |
|----------|--------------|---------------|

Appeal 2007-2159
Application 09/892,767

| | | |
|--------|-----------------|---------------|
| Lewis | US 5,564,001 | Oct. 8, 1996 |
| Liu | US 5,953,005 | Sep. 14, 1999 |
| Catona | US 6,288,319 B1 | Sep. 11, 2001 |

THE REJECTIONS

Claims 1-13, 15, 18, 20-25, 27, 30, 31, and 33-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Catona in view of Landante.

Claims 14, 16, 19, 20, 26, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Catona in view of Landante, and further in view of Lewis.¹

Claims 17, 32, and 40-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Catona in view of Landante, and further in view of Liu.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for the respective details thereof.

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their

¹ We note that the Examiner has applied two §103 rejections to independent claim 20 (Catona in view of Landante, and also Catona in view of Landante, and further in view of Lewis) (*See* Ans. 3, 5).

established functions.” *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case.

ISSUE(S)

The issue is whether Appellants have shown the Examiner erred in holding the cited combination of prior art would have rendered the claimed subject matter obvious to an artisan having ordinary skill and common sense at the time of the invention. More particularly, we decide the following issues we have determined are dispositive in this appeal:

(1) Whether Appellants have shown the Examiner erred in finding that the combination of Catona and Landante teaches and/or suggests recording the karaoke performance as an MMS message.

(2) Whether Appellants have shown the Examiner erred in finding the Catona and Landante references are further combinable under section 103 with the telephone taught by the Lewis reference.

(3) Whether Appellants have shown the Examiner erred in finding that the combination of Catona, Landante, and Liu teaches and/or suggests editing a recorded message by adding text or video.

ANALYSIS

Claims 1-13, 15, 18, 20-25, 27, 30, 31, and 33-39

We consider the Examiner's rejection of claims 1-13, 15, 18, 20-25, 27, 30, 31, and 33-39 as being unpatentable over the teachings of Catona in view of Landante. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will select independent claim 35 as the representative claim for this rejection because we find it is the broadest independent claim in this group. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

At the outset, we find it unnecessary to reach the question of whether the Examiner's proffered combination of Catona and Landante teaches or suggests a "MMS multimedia message server" (*See* independent claims 1, 20, and 34). While Appellants have argued this limitation in the Brief (*See* App. Br. 7), Appellants have also elected to have claims 1-13, 15, 18, 20-25, 27, 30, 31, and 33-39 considered as a single group (*Id.*). Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2004), we have selected independent claim 35 as the representative claim for this rejection because we find it is the broadest independent claim in this group. Significantly, we note that

representative claim 35 does not recite the argued limitation of a “MMS multimedia message server” (*See* claim 35).

Appellants further contend that the combination of Catona and Landante fails to teach recording the karaoke performance as an MMS message (App. Br. 8). Thus, we decide the question of whether Appellants have shown the Examiner erred in finding that the combination of Catona and Landante teaches and/or suggests recording the karaoke performance as an MMS message.

Non-functional Descriptive Material

The question before turns upon whether the “MMS message” of representative independent claim 35 should be accorded patentable weight as “functional descriptive material.” We begin our analysis by noting that “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. In contrast, “non-functional descriptive material” is a term coined by the USPTO to refer to any data or information content that does not exhibit a functional interrelationship with the substrate and does not affect the way the computing processes are performed. *See Examination Guidelines for Computer-Related Inventions*, 1184 Off. Gaz. U.S. Pat. & Trademark Office (O.G.) 87, 89 (March 26, 1996) (“‘Non-functional descriptive material’ includes but is not limited to music, literary works and a compilation or mere arrangement of data.”).

When “non functional descriptive material” is recorded or stored in a memory or other medium (i.e., substrate) it is treated as analogous to printed matter cases where what is printed on a substrate bears no functional relationship to the substrate and is given no patentable weight. *See In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight.”). *See also Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1003; affirmed without opinion Jun. 12, 2006). The Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). *See also Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1103; affirmed without opinion Aug. 17, 2006); Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d at 1339.

As an initial matter, we find that the claimed “karaoke performances” and “plurality of songs in karaoke format” are non-functional descriptive material (i.e., music). In other words, we find the recited storing and recording steps of claim 35 do not change their functions based upon the

content of the music. Because we find the music data (i.e., “karaoke performances” and “plurality of songs in karaoke format”) bears no functional relationship to the substrate (i.e., the storage or recording medium), we accord these claim limitations no patentable weight as non-functional descriptive material.

A closer question before us is whether the claimed “MMS message” represents functional or non-functional descriptive material. Appellants’ Specification discloses that the multimedia messaging service (MMS) enables users of cellular telephones to send and receive messages consisting of various media types (Spec. 1, ¶0003). Appellants further disclose that MMS “is well known in the telecommunications world and has been standardized” (Spec. 1-2).²

After carefully considering the language of representative independent claim 35, we find no claimed step of sending or receiving an MMS message where MMS functions as a multimedia communication protocol. Instead, we find method claim 35 records non-functional descriptive material (i.e., a selected karaoke song) “as an MMS message” (*See* claim 35). While the language of claim 35 may arguably implicitly require a conversion from an unspecified karaoke audio format to the MMS message format before the recording step is performed, we find no evidence of record that indicates the function of the claimed recording step is changed according to the particular format of the data. Moreover, no express step of MMS message format

² *See* “Standard 23.140 of the 3 GPP-3G Partnership Project at www.3gpp.org” (Spec. 2).

conversion or encoding is positively recited in the claim (*Id.*). Thus, we conclude that regardless of whether the karaoke songs are encoded in some unspecified audio format or as an MMS message, *the recorded karaoke data still represents music data* (i.e., non-functional descriptive material). Just as a step of recording (or a recording device) is not patentable merely because it is capable of recording a particular arrangement of music data (non-functional descriptive material), we find Appellants' claimed invention unpatentable for the same reason. Although we have fully considered the limitations associated with the claimed steps of storing and recording, we accord no patentable weight to the karaoke song data (i.e., non-functional descriptive material), regardless of whether such song data is represented in an unspecified audio format or as an MMS message. While the MMS message may contain various elements of structured data to facilitate communication of content via cellular telephones, we find no express limitations to any of those elements beyond mere content (non-functional descriptive material). Thus, we find the difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

Because we have determined that no patentable weight is properly accorded to the content limitations argued by Appellants, we find Appellants have not shown error in the Examiner's proffered combination of Catona and Landante which teaches and/or suggests Appellants' claimed invention. Specifically, we find Catona teaches and/or suggests a step of storing (see

pre-recorded song 30, Fig. 2, col. 3, l. 12) and a step of recording a mixed track 44 when mixed track 44 is sent to the server (i.e., necessarily recorded on the server) and subsequently assembled into a greeting card at steps 66 and 68, as shown in Fig. 3.

We note that Appellants have presented no arguments in the Appeal Brief directed to the combinability of Catona and Landante with respect to the claims in this group.³ In the Reply Brief, however, Appellants present a new argument that the Examiner has impermissibly relied upon in hindsight in formulating the rejection (Reply Br. 4). This argument, which was presented for the first time in the Reply Brief without a showing of good cause, is untimely and will not be considered. Appellants could have raised this argument in the Appeal Brief. The term “Reply Brief” is exactly that, a Brief in reply to new rejections or new arguments set forth in an Examiner’s Answer. Appellants may not present their arguments in a piecemeal fashion, holding back arguments until an Examiner answers their original Brief. *See also Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (an issue not raised in an opening brief is waived). We note that if Appellants wish to have new arguments considered by the Examiner, the proper procedure is to file a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114.

Thus, for at least the aforementioned reasons, we find Appellants have failed to rebut the Examiner’s legal conclusion of obviousness by

³ See Supplemental Appeal Brief, filed Aug. 12, 2004, pp. 7-12.

establishing insufficient evidence of *prima facie* obviousness or evidence of secondary indicia of nonobviousness. Therefore, we sustain the Examiner's rejection of representative claim 35 as being unpatentable over Catona in view of Landante.

Pursuant to 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to the remaining claims in this group on the basis of the selected claim alone. Therefore, we will sustain the Examiner's rejection of claims 1-13, 15, 18, 20-25, 27, 30, 31, and 33, 34, and 36-39 as being unpatentable over Catona in view of Landante for the same reasons discussed *supra* with respect to representative claim 35.

Claims 14, 16, 19, 20, 26, 28, and 29

We consider next the Examiner's rejection of claims 14, 16, 19, 20, 26, 28, and 29 as being unpatentable over the teachings of Catona in view of Landante, and further in view of Lewis. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will select dependent claim 16 as the representative claim for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

At the outset, Appellants contend that dependent claims 14, 16, 19, 20, 26, 28, and 29 are patentable at least by virtue of their dependency from independent claims 1 and 20. (App. Br. 12).

In response, we have determined that independent claims 1 and 20 are unpatentable over Catona in view of Landante, as discussed *supra*.

We note that the language of representative claim 16 requires the user interface to be a fixed telephone. We agree with the Examiner that Lewis teaches the use of telephone 53 as a user interface in Fig. 2A in the context of a multimedia system. Lewis expressly discloses that “the program source material stored in the MCPS 44 [multimedia call processing system 44] are interactively accessed by a user through a telephone 53.” (Lewis, col. 5, l. 67 through col. 6, l. 2).

Nevertheless, Appellants further contend that the Examiner’s proffered combination of Catona, Landante, and Lewis would not reasonably be expected to be successful as required by MPEP § 2143.02 (App. Br. 13).

Thus, we decide the question of whether Appellants have shown the Examiner erred in finding that the Catona and Landante references are combinable under section 103 with the telephone taught by the Lewis reference. Specifically, Appellants contend that substituting a telephone or cell phone for the user interface of Catona (i.e., the user’s computer) would not have a reasonable expectation of success because there is no teaching that the telephone has the memory or processing capabilities that are required by the user interface taught in Catona (App. Br. 13).

We disagree. We find the Examiner’s proffered combination merely substitutes the telephone interface of Lewis in place of Catona’s audio player 32 and microphone 36 (*See* Catona, col. 2, ll. 61-63). Thus, Catona’s computer system would have provided the requisite memory and processing

capabilities, with the telephone of Lewis providing the user interface (i.e., the speaker and microphone capabilities).

Moreover, after carefully considering the evidence before us, we find the Examiner's proffered combination of Catona, Landante, and Lewis reasonably teaches and/or suggests Appellants' claimed invention in terms of *familiar elements* that would have been combined by an artisan having common sense using *known methods* to achieve a *predictable result*. We note that karaoke systems were notoriously well known in the art, as evidenced by Catona (*See* Catona, Fig. 3, col. 2, l. 7). Likewise, the use of a telephone as a user interface to a multimedia system was known in the art, as taught by Lewis (*See* Lewis, col. 5, l. 67 through col. 6, l. 1; *see also* Fig. 2A). "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739).

Here, we find Catona, Landante, and Lewis have complementary features that would have reasonably lead an artisan having ordinary skill and common sense to combine their respective teachings in the manner suggested by the Examiner. Our reviewing court has stated: "[t]he use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699

F.2d 1331, 1333 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968)).

Moreover, Appellants have not shown that the claimed combination of familiar elements produces a new or non-obvious function. Appellants have not provided any factual evidence of secondary considerations such as unexpected or unpredictable results, commercial success, long felt but unmet need, etc. Thus, when we take account of the inferences and creative steps that a person of ordinary skill in the art would have employed, we conclude the Examiner has articulated an adequate reasoning with a rational underpinning that reasonably supports the legal conclusion of obviousness.

Therefore, we sustain the Examiner's rejection of representative claim 16 as being unpatentable over Catona in view of Landante, and further in view of Lewis. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to the remaining claims in this group on the basis of the selected claim alone. Therefore, we will sustain the Examiner's rejection of claims 14, 19, 20, 26, 28, and 29 as being unpatentable over Catona in view of Landante and Lewis for the same reasons discussed *supra* with respect to representative claim 16.

Claims 17, 32, and 40-42

We consider next the Examiner's rejection of claims 17, 32, and 40-42 as being unpatentable over the teachings of Catona in view of Landante, and further in view of Liu. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will select claim 17 as the representative claim for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2005).

We note that the language of representative claim 17 requires the user to edit the recorded message by adding at least one of text and video.

Appellants argue that Liu's system does not allow a user to edit a recorded message by adding text or video. In particular, Appellants contend that text (i.e., Lyrics 102) and video 96 (shown in Liu's Fig. 4) are combined *before* the karaoke performance (App. Br. 14).

Therefore, we decide the question of whether Appellants have shown the Examiner erred in finding that the combination of Catona, Landante, and Liu teaches and/or suggests editing a recorded message by adding text or video.

We begin our analysis by noting that the Examiner fails to respond to Appellants' point of argument in the Answer. After carefully considering all of the evidence before us, we will reverse the Examiner's rejection of representative claim 17 for essentially the same reasons argued by Appellants' in the Brief. We find nothing in Liu's description of Fig. 4 that indicates the user performs editing of a recorded message by adding at least

one of text and video, as required by the language of representative claim 17. To the contrary, we find Liu discloses that step 106 of Fig. 4 merely *assembles* audio, video, timing, and lyric data before playing (*See* Liu, col. 5, ll. 6-8). Because dependent claims 32 and 40-42 recite equivalent limitations, we also reverse the Examiner's rejection of these claims as being unpatentable over the teachings of Catona in view of Landante, and further in view of Liu.

DECISION

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1-16, 18-31, and 33-39 under 35 U.S.C. § 103(a) for obviousness. However, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting claims 17, 32, and 40-42 under 35 U.S.C. § 103(a) for obviousness. Therefore, the decision of the Examiner rejecting claims 1-42 is affirmed-in-part.

Appeal 2007-2159
Application 09/892,767

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

rwk

SUGHRUE, MION, ZINN,
MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington DC 20037-3213